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D. REMARKS

Status of Claims

Claims 1-39 are pending in the application. Claims 1-37 and 39 are amended.

Interview Summary

On April 6, 2005 at 2 PM EST, an interview was conducted via telephone between Amy Pattillo, Applicants' Representative, and Examiner Rexford Barnie. No exhibits were shown, nor demonstrations conducted.

Applicants' representative and the Examiner discussed claim 1, and in particular, a proposed amendment to claim 1. The prior art cited against claim 1 is Swope et al. (US Patent 6,639,977) under 35 USC 102(b). In particular, Applicants proposed an amendment to claim 1 that would incorporate claim 12 into claim 1. The Examiner rejected claim 12 on the grounds that "Swope teaches a plurality of accounts which can selectively be used for paying for call services." [Office Action, p. 3] Applicants asserted that Swope discloses that a called party can select an account to which telephone service charges are billed, but Swope does not teach allowing a caller to initiate a billed transaction and the caller to select an account to which an amount of a billed transaction is credited. The Examiner explained that several errors were made in the response and that one of those errors was that claim 12 should have been rejected on the same grounds as claims 24 and 36. Claims 24 and 36 are rejected under 35 USC 103(a) as being unpatentable over Swope in view of Manto (US Patent 6,788,771). The Examiner used the interview to correct the error and noted that claim 12 is now rejected under 35 USC 103(a) as being unpatentable over Swope in view of Manto. In addition the Examiner suggested that Applicants' representative review Manto and determine whether there is sufficient reason to combine Swope and Manto. The Examiner assured Applicants' representative that before any subsequent rejection, the Examiner would call Applicants to discuss Applicants' response. In conclusion, no agreement with respect to the claims was reached. Applicants are filing this response with additional arguments for further review by the Examiner.

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In addition, during the interview, the Examiner corrected several other errors. In particular, the Examiner noted that on page 3 of the Office Action, claims 13, 25, and 37-39 are rejected under 35 USC 103(a) as being unpatentable over Swope in view of Bauer et al (US Patent 6,061,436), but that the rejection actually should only be a rejection under 35 USC 102(b) where the claims are anticipated by Swope.

35 USC § 102(b)

Claims 1-5, 7, 8, 10, 13, 25, 37-39

Claims 1-5, 7, 8, 10, 13, 25, and 37-39 stand rejected under 35 U.S.C. §102(b) as being anticipated by Swope et al. (US Patent Number 6,639,977). [Office Action, p. 2] The rejection is respectfully traversed in view of the amended claims. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed Cir. 1987). Furthermore the reference must be an enabling disclosure of each and every element as set forth in the claim. *In re Hoecksmas*, 158 USPQ 596, 600 (CCPA 1968); *In re LeGrive*, 133 USPQ 365, 372 (CCPA 1962). Because Swope does not teach each and every element of claims 1-5, 7, 8, 10, 13, 25, or 37-39 or enable each and every element of these claims, these claims are not anticipated, the rejection should be withdrawn, and the claims should be allowed.

Claims 1, 13, and 25

With regards to claims 1, 13, and 25, independent method claim 1, which is representative of independent system claim 13 and independent computer program product claim 25, with regard to similarly recited subject matter and rejection, reads as follows:

1. (Currently Amended) A method for billing for [telephone] services provided by a caller originating a call, said method comprising:
 receiving a request to originate a billed transaction for a service provided by a caller from an origin device;
 authenticating an identity of a callee answering a call originated by said origin device; and

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responsive to receiving an acceptance of said call by said callee from a destination device, billing an account accessed by said authenticated identity of said callee for a cost of said service and crediting said cost to a caller account to complete said billed transaction when said service provided by said caller is complete, such that said origin device is enabled to initiate said billed transaction charged to said callee for said service provided by said caller to said callee during said call.

Applicants have amended claim 1 to clarify that Swope does not teach, expressly or inherently, the invention of claim 1. In particular, Applicants respectfully assert that Swope does not teach, expressly or inherently, or enable the invention of amended claim 1 because Swope does not teach or enable receiving a request to originate a billed transaction for a service provided by a caller from an origin device or billing an account accessed by said authenticated identity of said callee for a cost of said service and crediting said cost to a caller account to complete said billed transaction. Because Swope does not teach or enable the invention of amended claim 1, Applicants respectfully request withdrawal of the rejection and allowance of the claim.

Applicants note that in the rejection of claim 1, the Examiner stated the following grounds of rejection:

receiving a request to originate a billed transaction for a caller from an origin device (see col. 3);
 authenticating an identity of a called party answering a call originated by the origin device (see fig. 3B, col. 5 lines 24-42); and
 responsive to receiving an acceptance of the call by the called party from the destination device, billing an account accessed by the authenticated identity of the called party to complete the billed transaction, such that the origin device is enabled to initiate the billed transaction charged to the called party in (see col. 1 lines 5-14, fig 3B, col. 7 lines 7-33, col. 5). [Office Action, p. 2]

Col. 3, lines 5-14 of Swope read:

“The present invention allows a calling party to call a destination number and, upon approval of the called party, reverse the billing of the telephone call so that it is deducted from an account owned and maintained by the called party other than the account associated with the destination number. Thus, the present invention provides an alternative reverse billing method to a conventional collect call. The account can be a credit card account, a checking or savings account

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having an associated debit or checking card, a conventional pre-paid calling card, or a special prepaid account as described herein.”

Thus, Swope describes a collect call service in which a called party selects the account to bill for the collect call.

First, Swope does not teach receiving a request to originate a billed transaction for a service provided by a caller from an origin device because Swope does not teach a caller providing a service during a call. Swope discloses that charges for the telephone service provided by a telephone service provider are charged to an account selected by the called party. *Swope*, col. 3, lines 5-10, col 6, lines 14-19. Swope does not teach or enable a caller providing any service during the call, but only that a caller can request that the called party pay for the telephone service provided by a service provider. In contrast, claim 1 teaches receiving a request to originate a billed transaction for a service provided by a caller from an origin device.

The specification supports the amended element of receiving a request to originate a billed transaction for a service provided by a caller from an origin device throughout. *See* Specification, page 13, lines 1-9, page 27 line 27 through page 28 line 3, page 28 line 13 through page 29 line 6. In one example, page 13, lines 1-9 teach that:

a business may provide a number that a caller may call, where the intermediary device will automatically initiate a billed transaction of a tariff from the callee to the caller. For example, a business may publish a telephone number that callers may call in order to participate in a survey. A billed transaction is initiated by the caller dialing the number and the tariff for completing the survey is transferred at the end of the call.

Second, Swope does not teach billing an account accessed by said authenticated identity of said callee for a cost of said service and crediting said cost to a caller account to complete said billed transaction because Swope does not teach crediting a caller account to complete a billed transaction. Swope discloses that the billing for the telephone call is charged to a called party account number. *Swope*, col. 3, lines 5-10, col 6, lines 14-19. Swope does not teach crediting the caller with the cost charged to a called party for a service provided by the caller. In contrast, claim 1 teaches billing the called party account for the cost of the service provided by the caller and crediting the caller account with the cost of the service.

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The specification supports the amended element of billing an account accessed by said authenticated identity of said callee for a cost of said service and crediting said cost to a caller account to complete said billed transaction when said service provided by said caller is complete throughout. See Specification, page 13, lines 1-9, page 28 lines 27-29, page 39 lines 11-16, page 41 lines 26-29. In one example, page 41 lines 26-29 read:

The billed transaction service advantageously accesses the callee's selected account to debit an amount according to the callee's RVID and then accesses the caller's account to credit the amount according to the caller's VID.

In conclusion, at least one element of amended claims 1, 13, and 25 is not taught, expressly or inherently, or enabled by Swope. Therefore, because Swope does not anticipate claims 1, 13, and 25, Applicants respectfully request allowance of claims 1, 13, and 25.

Claims 2-5, 7, 8, and 10

Regarding claims 2-5, 7, 8, and 10, Applicants respectfully propose that because Swope does not anticipate amended independent claim 1 upon which these dependent claims rely, Swope also does not anticipate these dependent claims and the dependent claims should be allowed. In addition, applicants note that claims 2-5, 7, 8, and 10 are amended to reflect the amendments made to claim 1.

Specifically, however, Applicants respectfully propose that even if Swope anticipates independent claim 1, Swope does not anticipate claims 2, 3, and 5.

In the rejection of claim 2, the Examiner states:

Swope teaches the claimed subject matter of being able to use one of a plurality of payment options. [Office Action, p. 3]

Applicants respectfully assert that regardless of the Examiner's assertion as to Swope's teaching, claim 2 is amended to clarify that Swope does not teach claim 2. In particular, claim 2 now reads:

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2. (Currently Amended) The method for billing for telephone services according to claim 1, further comprising:
only prompting said caller to provide said service [completing said billed transaction] if said callee is one of a plurality of callees authorized to accept said billed transaction for said service.

Swope discloses a reverse billing system where a called party can select an account to bill for the telephone service charges for a call. Swope does not teach prompting the caller to provide a service and Swope does not teach the method of prompting the caller only if the callee is one of the callees authorized to accept the billed transaction for the service provided by the caller. In contrast, the present invention teaches that the caller is prompted to provide the service only after detecting the identity of the callee is determining that the callee is one of the selection of authorized callees for receiving the service.

The specification supports the amended element of only prompting said caller to provide said service if said callee is one of a plurality of callees authorized to accept said billed transaction for said service throughout. See Specification page 38 lines 9-15, page 40, lines 15-22, page 42 lines 9-12. In one example, page 40 lines 15-22 read:

In the example, the origin initiated billed transaction specifies the identity of the callee authorized to accept the daily stock picks service. The line subscriber of the destination device, as indicated in line subscriber profile 54, is not an authorized callee. However, after an RVID 57 is determined for the actual callee answering a call at the destination device, RVID 57 indicates that the callee is "Bill Smith" with ID "231-00-6666".

In conclusion, at least one element of amended claim 2 is not taught, expressly or inherently, or enabled by Swope. Therefore, because Swope does not anticipate claim 2, Applicants respectfully request allowance of claim 2.

With regard to claim 3, amended claim 3 reads as follows:

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3. (Currently Amended) The method for billing for [telephone] services according to claim 1, further comprising:

responsive to receiving said request to originate said billed transaction at a switch within a trusted telephone network providing a telephone service connection for said call, establishing a secure communication channel between a billing service provider outside said trusted telephone network and said trusted telephone network, wherein said billing service provider controls authenticating said identity of said callee answering said call, prompting said callee to accept said call with said service, accessing said account by said authenticated identity of said callee, and controlling billing said account accessed by said authenticated identity of said callee for said cost of said service and crediting said cost to said caller account to complete said billed transaction.

~~only completing said billed transaction if said callee is authorized to accept a service offered in association with said billed transaction.~~

Applicants respectfully assert that Swope does not teach a trusted telephone network handling a call establishing a secure connection to a billing service outside the trusted telephone network and allowing the billing service outside the trusted telephone network to handle the steps performed by the present invention. In contrast, claim 3 teaches that responsive to a switch within a trusted telephone network providing a telephone connection for a call receiving the request to originate the billed transaction, the trusted telephone network establishes a secure communication channel to a billing service provider outside the trusted telephone network. In particular, the specification supports amended claim 3 throughout, and for example, page 11 lines 10-12, page 15 line 3 through page 17 line 6, page 19 line 11 through page 20 line 2, page 22 line 23 through page 23 line 22, and page 36, lines 9-11. In conclusion, at least one element of amended claim 3 is not taught, expressly or inherently, or enabled by Swope. Therefore, because Swope does not anticipate claim 5, Applicants respectfully request allowance of claim 3.

With regards to claim 5, amended claim 5 reads as follows:

5. (Currently Amended) The method for billing for telephone services according to claim 1, receiving a request to originate a billed transaction for a service provided by a caller from an origin device further comprising:
receiving said request in which said caller specifies said cost for said service and a type of said service.

~~responsive to completing said billed transaction, providing a service to said callee via said call.~~

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As previously asserted by Applicants, Swope does not teach a caller providing a service. Swope also does not teach a caller specifying, in a request to initiate a billed transaction for the service, the cost of the service and a type of the service. In contrast, claim 5 teaches that a request to originate a billed transaction is received in which the caller specifies the cost of the service and a type of service to be provided. The specification supports the amendment to claim 5 throughout, and for example, at col. 10 lines 12-17, col. 28 lines 27-29, and col. 44 lines 9-14. In conclusion, at least one element of amended claim 5 is not taught, expressly or inherently, or enabled by Swope. Therefore, because Swope does not anticipate claim 5, Applicants respectfully request allowance of claim 5.

Claims 37-39

Claims 37-39 currently read as follows:

37. (Currently Amended) A method for controlling a billed transaction, comprising:

transferring a call to a destination device with a billed transaction request initiated by a caller placing said call to said destination device, wherein said billed transaction request is for a callee answering said call at said destination device to pay said caller for a service provided by said caller during said call;

authenticating an identity of [a] said callee answering said call at said destination device; and

executing said billed transaction according to a billing plan for said authenticated callee identity.

38. (Original) The method for controlling a billed transaction according to claim 37, further comprising:

only executing said billed transaction responsive to an authorization by said callee.

39. (Currently Amended) A method for controlling callee billing, comprising:

receiving a call at a destination device with a billed transaction request initiated by a caller placing said call, wherein said billed transaction request is for a callee answering said call at said destination device to pay said caller for a service provided by said caller during said call; and

responsive to an acceptance of said billed transaction request by a callee answering said call at said destination device, transferring an authorization to

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charge a billing plan accessed according to an authenticated identity of said callee.

The Examiner presents the following grounds for rejection of claims 37-39:

Regarding claims 37-38, Swope teaches a method for controlling a billed transaction in (see fig. 3A, col. 3 lines 27-30).

Regarding claim 39, Swope teaches a method for controlling a billed transaction in (see fig. 3A, col. 3 lines 27-30). [Office Action, p. 4]

First, Applicants respectfully assert that the grounds of rejection for each of claims 37-39, on their face, fail to show that Swope teaches each and every element or enable each and every element of claims 37-39. The claims do not merely teach the preamble of claims 37-38 "a method for controlling a billed transaction".

Second, regardless of whether the Examiner's rejection of claims 37-39 is sufficient to show how Swope teaches and enables each and every element of claims 37-39, Applicants amend claims 37-39 in a similar manner as the amendments to claim 1. In particular, Applicants amend claims 37 and 39 to clarify that a billed transaction request is a request for the callee to pay for a service to be provided by the caller during the call. As previously discussed with regard to claim 1, Swope does not teach a caller providing a service during a call. Therefore, Swope does not teach each and every element of amended claims 37 and 39, and claims 37 and 39 should be allowed. In addition, as a dependent claim of claim 37 which is amended to clarify that Swope does not teach the invention, dependent claim 38 should also be allowed.

35 USC § 103(a)

Claims 6, 9, 11, 14-23, and 26-35

Claims 6, 9, 11, 14-23, and 26-35 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Swope (US Patent Number 6,639,977) in view of Bauer et al. (US Patent Number 5,859,900)(hereinafter Bauer '900) or Bauer et al. (US Patent Number 6,061,436)(hereinafter Bauer '436). [Office Action, p. 5] Regarding claims 6, 9, 11, 14-23, and 26-35, Applicants respectfully propose that because claims 1, 13 and 25 are no longer anticipated by Swope, as claims dependent upon claims 1, 13, and 25, claims 6, 9, 11, 14-23, and 26-35 are

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not obvious under Swope in view of Bauer '900 or Bauer '436 the dependent claims should be allowed. Applicants note that claims 6, 9, 11, 14-23, and 26-35 are also amended to reflect the amendments to claims 1, 13, and 25; in addition, support for the amendment of claims 14 and 26 is stated with regard to claim 2, of claims 15 and 27 is stated with regard to claim 3, and of claims 17 and 29 is stated with regard to claim 5.

Claims 12, 24 and 36

Claims 12, 24, and 36 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Swope (US Patent Number 6,639,977) in view of Manto (US Patent Number 6,788,771). [Office Action, p. 6] Regarding claims 12, 24, and 36, Applicants respectfully propose that because claims 1, 13 and 25 are no longer anticipated by Swope, as claims dependent upon claims 1, 13, and 25, claims 12, 24, and 36 are not obvious under Swope in view of Manto the dependent claims should be allowed. Applicants note that claims 12, 24, and 36 are also amended to reflect the amendments to claims 1, 13, and 25.

In addition, the Examiner carries the burden of proving a prima facie case of obviousness for a 103(a) rejection. As previously amended, claims 6, 9, 11, 14-23, and 26-35 are not obvious in view of Swope in view of Bauer '900 or Bauer '436 and therefore the rejection should be withdrawn and the claims allowed.

With regards to claims 12, 24, and 36, dependent method claim 12, which is representative of dependent system claim 24 and dependent computer program product claim 36, with regard to similarly recited subject matter and rejection, reads as follows:

12. (Currently Amended) The method for billing for [telephone] services according to claim 1, further comprising:
prompting [a] said caller at said origin device to select [an] said caller account for crediting a cost [an amount] of said billed transaction.

The Examiner states the following grounds for the rejection of claims 12, 24, and 36:

In particular, regarding claims 24 and 36, Swope fails to teach the claimed subject matter but Manto teaches a system and method for providing sponsored or universal telecommunications service and third party payer services in (see 9 see fig 2a in the vicinity of the box labeled "generate message").

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Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Manto into that of Swope thus making it possible to charge or use any desired account for one's convenience. [Office Action p. 6]

The Examiner carries the burden of proving a prima facie case of obviousness for a 103(a) rejection. First, in establishing a prima facie case of obviousness under 103(a), the combined prior art references must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991). In particular, in determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983). Appellants respectfully note that the Examiner does not show, nor do the references teach or suggest, separately or in combination, the elements of claims 12, 24, and 36 when considered as a whole.

Applicants respectfully assert that the combination of Swope and Manto does not teach prompting said caller at said origin device to select said caller account for crediting a cost of said billed transaction because Manto only discloses charging a caller or called party for a call, not crediting a caller for the cost of a service provided by the caller and charged to the callee. Manto discloses solving the problem of how to provide telephone service to callers who cannot afford to maintain telephone service. Manto, col. 1, lines 25-31. Manto solves the problem by providing telephones at which a caller is either provided free service or the caller may select to charge the costs associated with the call to another account. *See* Manto, Fig 2a. Manto does not teach prompting a caller to select a caller account to which a cost is credited. Further, Manto does not teach prompting a caller to select a caller account to which a cost is credited for a service provided by the caller. In contrast, the present invention teaches, when considered as a whole, that the caller is prompted to select an account to which the cost of the serviced provided to the caller, as part of a billed transaction originated by the caller, are credited. Applicants amend claims 12, 24, and 36 to follow the amendments to claims 1, 13, and 25. Therefore, at

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least one element of claims 12, 24, and 36 is not taught by Swope and Manto, separately or in combination, and therefore claims 12, 24, and 36 are not obvious in view of the combination of Swope and Manto. Because claims 12, 24, and 36 are not obvious in view of the combination of Swope and Manto, prima facie obviousness is not established for claims 12, 24, and 36 and Applicants respectfully request allowance of these claims.

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Conclusion

Applicants note the citation of pertinent prior art cited by the Examiner.

In view of the foregoing, withdrawal of the rejections and the allowance of the current pending claims are respectfully requested. If the Examiner feels that the pending claims could be allowed with minor changes, the Examiner is invited to telephone the undersigned to discuss an Examiner's Amendment.

Respectfully submitted,

 ON 4/25/2005

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